

Serial Number 10/033,868
14X200134 / GLM-0084

REMARKS / ARGUMENTS

Status of Claims

Claims 1-15, all of the claims pending in the application, are rejected. No claim is allowed. Claims 1 and 8 are amended. Of the pending claims, Applicant herein provides clarifying remarks to traverse the rejections.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in detail of the position by the final rejection, which presented in substantially more detail the Examiner's interpretation of Coe (U.S. Patent No. 5,305,365) with specific reference to the "examination position". The claim amendments presented herein should only require a cursory review by the Examiner.

Rejections Under 35 U.S.C. §102(b)

Claims 1-15 are rejected under 35 U.S.C. §102(b) as being anticipated by Coe (U.S. Patent No. 5,305,365) (hereinafter, Coe). The Examiner comments that Coe teaches the invention as claimed including "...the arm being mounted for rotation about a first axis (i.e. common axis of outer tube 90 and inner tube 110; col. 4, lines 35-39) substantially perpendicular to the direction of the examination arm *and passing through the center of an examination position...*" (emphasis added) (Paper 9, page 3). Applicant traverses this comment for the following reasons.

Coe discloses a mammography system with a variable angle, rearwardly tilting mammograph adjustable to individual, standing or sitting patients in forwardly leaning posture to maximize breast tissue exposure to the mammograph by gravity (Abstract). Included in Coe's mammography system is an examination arm (12) mounted for rotation about a first axis (common axis of outer tube 90 and inner tube 110; col. 4, lines 35-39). However, notably absent from Coe is any disclosure of the first axis passing through the

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center of an examination position intended for an object to be examined, such that a switch-over from a cranio-caudal image to a side view image may result from rotation of the examination arm about the first axis with the object to be examined substantially stationary.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner states that "*the teaching of Coe is interpreted as* having the first axis passing through the center of an examination position", and that "[t]he area between the head and the receiver of Coe *is interpreted as* the 'examination position' ". (Paper 9, page 5) (Emphasis added).

At the outset, Applicant respectfully submits that a claim is anticipated under 35 U.S.C. §102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and not merely taught by the reference where an interpretation, absent specific disclosure, is necessarily required for the rejection.

To further define the boundaries of what Applicant considers to be the "examination position", as commented on by the Examiner at paper 9, page 5, Applicant herein amends independent Claims 1 and 8 to include the elements of "...the arm being mounted for rotation about a first axis substantially perpendicular to the direction of the examination arm and *passing through the center of an examination position intended for an object to be examined, such that a switch-over from a cranio-caudal image to a side view image may result from rotation of the examination arm about the first axis with the object to be examined substantially stationary...*" (Emphasis added).

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In comparing Coe with the instant invention, Applicant respectfully submits that Coe does not disclose each and every element of Claims 1 and 8. Dependent claims inherit all of the limitations of the respective parent claim.

In support of the Examiner's position, the Examiner alleges that Coe includes a breast compression paddle (18) that is adjustable in a direction parallel with the examination arm (12), that the paddle (18) is therefore adjustable above the "first axis" (common axis of tubes 90, 110), and that the teaching of Coe is interpreted as having the first axis passing through the center of the "examination position" where the "examination position" is interpreted to be the area between the head (10) and the receiver (16). (Paper 9, page 5).

In comparing the amended claim language with the Examiner's interpretation, Applicant finds Coe, as best understood from the Examiner's interpretation, to disclose an "examination position" (i.e., the area between the head (10) and the receiver(16)) that is substantially different from the claimed "examination position" (i.e., an examination position intended for an object to be examined, such that a switch-over from a cranio-caudal image to a side view image may result from rotation of the examination arm about the first axis with the object to be examined substantially stationary). If the Examiner's interpretation of Coe's "examination position" reflects an accurate disclosure of Coe, then the first axis may possibly pass through the center of Coe's "examination position", but as disclosed in Figure 1, does not appear to necessarily pass "through the center of an examination position intended for an object to be examined, such that a switch-over from a cranio-caudal image to a side view image may result from rotation of the examination arm about the first axis with the object to be examined substantially stationary", as claimed.

Paragraphs [0006] and [0013] disclose the claimed structure as being able to switch-over from a cranio-caudal image to a side view (or vice-versa) without needing to move the organ to be examined, such as the patient's breast, which results from the axis of rotation of the examination arm (first axis) passing through the center of the examination position intended for the object (the patient's breast) to be examined.

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In comparison, Coc discloses in Figure 1 a first axis (common axis as discussed previously) that does not pass through the center of *the examination position intended for the object to be examined*, and therefore cannot provide the advantage provided for in the invention as disclosed and claimed.

Applicant has amended Claims 1 and 8 for presentation in a better form for consideration on appeal that more clearly reflects Applicant's invention, and respectfully submits that Coc does not disclose each and every element of the claimed invention and discloses a substantially different invention than the claimed invention, and therefore cannot be anticipatory.

In view of the foregoing amendment and remarks, Applicant respectfully submits that the proposed amendments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the application is now in condition for allowance. Such action is therefore respectfully requested.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 09-0470.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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